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FRISHAUF, HOLTZ, GOODMAN &
CHICK, PC
220 5TH AVE FL 16
NEW YORK, NY 10001-7708

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In re Patent No. 7,335,765 : REQUEST FOR RECONSIDERATION
Kaneko et al. : OF DECISION
Issue Date: February 26, 2008: ON APPLICATION FOR
Application No. 09/925,673 : PATENT TERM ADJUSTMENT
Filed: August 9, 2001 :
Atty Docket No. 01376CIP/HG :

This is a decision on the "REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT" filed February 14, 2008. This decision is made in light of the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))" filed March 20, 2008. Patentees request reconsideration of the 225 days of patent term adjustment indicated in the above-identified issued patent. Patentees request correction of the patent term adjustment to one thousand sixty-seven (1067) days (225 days plus 842 days).

The request for reconsideration of patent term adjustment is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

BACKGROUND

On July 26, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 195 days.

On September 6, 2007, patentees timely filed the initial application for patent term adjustment. Patentees requested entry of a period of adjustment of two hundred seventy-eight (278) days for Office delay pursuant to 37 CFR 1.702(a)(2) for the period from four months after the payment of the issue fee on June 27, 2005 to the mailing date of the Office action on August 1, 2006.

By decision mailed January 4, 2008, the petition was dismissed. Patentees were advised that 37 CFR 1.702(a)(4) is the rule relevant to the calculation of Office delay in taking action in response to payment of the issue fee (and satisfaction of all outstanding requirements). In addition, patentees were advised that entry of a period of adjustment pursuant to 37 CFR 1.702(a)(4) was not warranted. Citing the final rule,

the date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000),

the Office determined that any period of adjustment calculated under 37 CFR 1.702(a)(4) would run from the date the issue fee was paid in response to the new notice of allowance, September 27, 2007, until the issuance of the patent. (It is noted that as of the mailing of the first decision, the patent had not issued).

OPINION

On February 26, 2008, the application matured into U.S. Patent No. 7,335,765, with a revised patent term adjustment of 225 days. After the mailing of the notice of allowance, a period of adjustment of 30 days was entered pursuant to 37 CFR 1.702(a)(4).

On February 14, 2008, patentees timely submitted this request for reconsideration of the decision on application for patent term adjustment mailed January 4, 2008. Prior to a decision being rendered on the renewed application for patent term adjustment, on March 20, 2008, patentees filed a supplement to the request for reconsideration (in view of the issuance of the patent on February 26, 2008). Patentees assert that the patent term adjustment of 225 days indicated on the patent is in error. Patentees argue that the error is based on the failure of the USPTO to account for a USPTO delay of 842 days, which arose from the June 22, 2006 withdrawal from issue on the initiative of the USPTO after the issue fee was paid on June 27, 2005, which resulted in the patent not issuing until February 26, 2008.

Patentees' arguments have been reconsidered, but not found persuasive.

Patentees calculate an additional period of adjustment of 842 days on the basis that the patent issued on February 26, 2008, which is 872 days after 4 months from the payment of the issue fee on June 27, 2005. This request for 842 days recognizes that a period of adjustment of 30 days has been entered on the basis that the patent issued on February 26, 2008, which is 30 days after 4 months from the date of payment of the issue fee and satisfaction of all outstanding requirements. Patentees indicate that this request is based on 37 CFR 1.702(a)(4).

However, patentees continue to allude to 37 CFR 1.702(a)(2) as a possible basis for relief. As such, it is appropriate to preliminarily state that the Office's actions with respect to issuance of the patent after payment of the issue fee and satisfaction of all outstanding requirements do not pertain to 37 CFR 1.702(a)(2). 37 CFR 1.702(a)(2) provides for adjustment of patent term due to Office failure to respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken. Payment of the issue fee is not a reply under 35 U.S.C. 132 (or of course, an appeal taken under 35 U.S.C. 134). 37 CFR 1.702(a)(2) does not pertain to a delay in taking action after payment of the issue fee. The asserted period of delay is not a period of delay within the meaning of 37 CFR 1.702(a)(2).

With respect to the mailing of the August 1, 2006 Office action, patentees state that the Office unduly delayed in for the first

time applying the Wengel et al. specification to reject the applicants' claims, after the Office withdrew the above-identified application from issue more than a year after applicants paid the issue fee on June 27, 2005. It is regretted that more than a year elapsed from the withdrawal of the application from issue until the mailing of the Office action on August 1, 2006. However, every delay by the Office (or applicant) is not set forth as a basis for entry of a period of adjustment (or a period of reduction). There is no basis in the statute or rules for entry of a period of adjustment for Office delay in taking action after withdrawing an application from issue.

Rather, with respect to the relevant delay in issuing the patent, sections 1.702(a)(4) and 1.703(a)(6) apply. 35 USC 154(b)(1)(A)(iv) provides for entry of a period of adjustment for Office failure to:

issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

37 CFR 1.702(a)(4), implements the statute, by providing for adjustment of patent term due to Office failure to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied. This is precisely the failure that patentees assert gives rise to entry of a period of adjustment of 872 days.

Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv) and § 1.702(a)(4). Section 1.703(a)(6) specifies that:

the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued.

Patentees' are incorrect in relying solely on the date of payment of the issue fee to calculate this period. As clearly stated in the rules and supported by the statute, the period

begins on the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied.

Further, it is proper for the Office to determine when all outstanding requirements are satisfied. The Office has stated in the final rule:

the date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

This interpretation is not inconsistent with the statute. Both the statute and the rule consider Office delay based on the date the Office takes action after the issue fee is paid and all outstanding requirements are met. Payment of the issue fee in of itself may not be sufficient to have the patent issue. A patent cannot issue until all outstanding requirements necessary to be satisfied for its issuance have been met. Accordingly, the Office is not deemed to have engaged in examination delay until 4 months after the issue fee has been paid and all outstanding requirements have been met.

Moreover, where prosecution in an application is reopened after allowance, all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151. After reopening of prosecution, the patent cannot issue until all outstanding requirements necessary to be satisfied for its issuance have been met. In the circumstance where the Office determines that withdrawal of the application from issue is appropriate, prosecution is reopened and the patent cannot issue until the matter that served as the basis for the withdrawal from issue is addressed, and if at all, a new Notice of Allowance is issued. Further, regardless of the previous payment of the issue fee, all outstanding requirements are not met until an applicant replies to the new notice of allowance. For the patent to issue (and the application not to be

considered abandoned), applicant must return Part B of the issue fee transmittal. Thus, it is proper to consider all outstanding requirements not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 and applicant properly responds to the new notice of allowance.

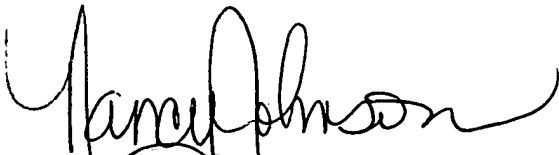
In this instance, a new notice of allowance was mailed July 26, 2007 and all outstanding requirements were met when the new issue fee transmittal was submitted on September 27, 2007. The conclusion that the controlling date in calculating the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(4) is the date of submission of the issue fee transmittal on September 27, 2007 in response to the new notice of allowance mailed July 26, 2007 is affirmed. The period of adjustment of 30 days is correct.

CONCLUSION

The patent issued with a correct patent term adjustment of two hundred twenty-five (225) days.

Patentees' submission of the \$200.00 fee set forth in 37 CFR 1.18(e) on initial application for patent term adjustment is acknowledged. No additional fee is required on request for reconsideration of decision on application for patent term adjustment.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions